

REISSUE APPLICATION DECLARATION BY THE INVENTOR

Docket Number (Optional)

5355-RE02

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are stated below next to my name.

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is described and claimed in patent number 5,472,790, granted December 5, 1995, and for which a reissue patent is sought on the invention entitled PREPARATION AND TRANSFER SHEET

the specification of which

☒ is attached hereto.

☐ was filed on _____ as reissue application number ____ / _____
and was amended on _____
(If applicable)

I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR 1.56.

I verily believe the original patent to be wholly or partly inoperative or invalid, for the reasons described below. (Check all boxes that apply.)

☐ by reason of a defective specification or drawing.

☒ by reason of the patentee claiming more or less than he had the right to claim in the patent.


☐ by reason of other errors.

At least one error upon which reissue is based is described as follows:

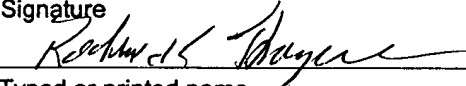
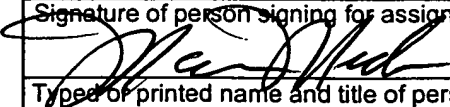
See Supplemental Reissue Declaration by Inventor, submitted herewith.

[Page 1 of 2]

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

(REISSUE APPLICATION DECLARATION BY THE INVENTOR, page 2)		Docket Number (Optional) 5355-RE02	
All errors corrected in this reissue application arose without any deceptive intention on the part of the applicant. As a named inventor, I hereby appoint the following attorney(s) and/or agent(s) to prosecute this application and transact all business in the Patent and Trademark Office connected therewith.			
Name(s)		Registration Number	
<u>Carl R. Brown, Reg. No. 18,587; Neil F. Martin, Reg. No. 23,088;</u>			
<u>John L. Haller, Reg. No. 27,795; James W. McClain, Reg. No. 24,536</u>			
<u>Lawrence D. Maxwell, Reg. No. 35,276</u>			
Correspondence Address: Direct all communications about the application to:			
<input type="checkbox"/> Customer Number		→	
OR		Type Customer Number here	
Place Customer Number Bar Code Label here			
<input type="checkbox"/> Firm or Individual Name	Lawrence D. Maxwell, Esq.		
Address	BROWN, MARTIN, HALLER & McCLAIN		
Address	1660 Union Street		
City	San Diego	State	CA
Country	U.S.A.		
Telephone	(619) 238-0999	Fax	(619) 238-0062
I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine and imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this declaration is directed.			
Full name of sole or first inventor (given name, family name)			
RODERICK THOMPSON			
Inventor's signature 			
Residence	Solana Beach, California		Date
Post Office Address	675 So. Sierra, #46 Solana Beach, CA 92075		Citizenship
Full name of second joint inventor (given name, family name)			
Inventor's signature		Date	
Residence		Citizenship	
Post Office Address			
Full name of third joint inventor (given name, family name)			
Inventor's signature		Date	
Residence		Citizenship	
Post Office Address			
<input type="checkbox"/> Additional joint inventors are named on separately numbered sheets attached hereto.			

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

REISSUE APPLICATION BY THE INVENTOR, OFFER TO SURRENDER PATENT		Docket Number (Optional) 5355-RE02
<p>This is part of the application for a reissue patent based on the original patent identified below.</p>		
Name of Patentee(s) RODERICK THOMPSON		
Patent Number 5,472,790	Date Patent Issued December 5, 1995	
Title of Invention PREPARATION AND TRANSFER SHEET		
<p>I am the inventor of the original patent. I offer to surrender the original patent.</p> <p>1. <input checked="" type="checkbox"/> Filed herein is a certificate under 37 CFR 3.73(b).</p> <p>2. <input type="checkbox"/> Ownership of the patent is in the inventor(s), and no assignment of the patent has been made.</p> <p>One of boxes 1 or 2 above must be checked.</p> <p>The written consent of all assignees owning an undivided interest in the original patent is included in this application for reissue. (See Supplemental Reissue Declaration by Inventor, submitted herewith.)</p>		
Signature 		Date 1-23-98
Typed or printed name RODERICK THOMPSON		
The assignee owning an undivided interest in said original patent is <u>NEW AGE PRODUCTS, INC.</u> , and the assignee consents to the accompanying application for reissue.		
I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that such willful false statements may jeopardize the validity of the application, any patent issued thereon, or any patent to which this declaration is directed.		
Name of assignee NEW AGE PRODUCTS, INC.		
Signature of person signing for assignee 		Date 1-26-98
Typed or printed name and title of person signing for assignee MARVIN MICK, President		

Burden Hour Statement: This form is estimated to take 0.1 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

**STATEMENT CLAIMING SMALL ENTITY STATUS
(37 CFR 1.9(f) & 1.27(c))—SMALL BUSINESS CONCERN**

Docket Number (Optional)
5355-RE02

Applicant, Patentee, or Identifier: RODERICK THOMPSON
Application or Patent No.: NEW
Filed or Issued: HEREWITH
Title: PREPARATION AND TRANSFER SHEET

I hereby state that I am

- ☐ the owner of the small business concern identified below:
☒ an official of the small business concern empowered to act on behalf of the concern identified below:

NAME OF SMALL BUSINESS CONCERN NEW AGE PRODUCTS, INC.

ADDRESS OF SMALL BUSINESS CONCERN 3060 Industry, Suite 108
Oceanside, CA 92054

I hereby state that the above identified small business concern qualifies as a small business concern as defined in 13 CFR Part 121 for purposes of paying reduced fees to the United States Patent and Trademark Office, in that the number of employees of the concern, including those of its affiliates, does not exceed 500 persons. For purposes of this statement, (1) the number of employees of the business concern is the average over the previous fiscal year of the concern of the persons employed on a full-time, part-time, or temporary basis during each of the pay periods of the fiscal year, and (2) concerns are affiliates of each other when either, directly or indirectly, one concern controls or has the power to control the other, or a third party or parties controls or has the power to control both.

I hereby state that rights under contract or law have been conveyed to and remain with the small business concern identified above with regard to the invention described in:

- ☒ the specification filed herewith with title as listed above.
☐ the application identified above.
☐ the patent identified above.

If the rights held by the above identified small business concern are not exclusive, each individual, concern, or organization having rights in the invention must file separate statements as to their status as small entities, and no rights to the invention are held by any person, other than the inventor, who would not qualify as an independent inventor under 37 CFR 1.9(c) if that person made the invention, or by any concern which would not qualify as a small business concern under 37 CFR 1.9(d), or a nonprofit organization under 37 CFR 1.9(e).

- Each person, concern, or organization having any rights in the invention is listed below:
☒ no such person, concern, or organization exists.
☐ each such person, concern, or organization is listed below.

Separate statements are required from each named person, concern or organization having rights to the invention stating their status as small entities. (37 CFR 1.27)

I acknowledge the duty to file, in this application or patent, notification of any change in status resulting in loss of entitlement to small entity status prior to paying, or at the time of paying, the earliest of the issue fee or any maintenance fee due after the date on which status as a small entity is no longer appropriate. (37 CFR 1.28(b))

NAME OF PERSON SIGNING Marvin Mick

TITLE OF PERSON IF OTHER THAN OWNER President

ADDRESS OF PERSON SIGNING 3060 Industry, Suite 108, Oceanside, CA 92054

SIGNATURE *Marvin Mick* DATE 1-26-98

BROWN, MARK **MARK & MCCLAIN**
1660 Union Street
San Diego, California 92101
Telephone: (619) 238-0999

Attorneys for Plaintiff, New Age Products, Inc.

**UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA**

NEW AGE PRODUCTS, INC.,

Plaintiff,

v.

**PROGRESSIVE INTERNATIONAL
CORP.,**

Defendant.

**PROGRESSIVE INTERNATIONAL
CORP.,**

Counterclaimant,

v.

NEW AGE PRODUCTS, INC.,

Counterclaim Defendant.

Civil Action No.: 962129 J CGA

DECLARATION OF JOHN COX:

I, JOHN COX, declare and state as follows:

- 1. I am a named inventor in U.K. Patent GB 2 248 177 and co-invented the flexible chopping mat described in that patent.**

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2. I was formerly a director of ROS Marketing of Newton Abbot, Devon, United Kingdom.
3. ROS Marketing has produced and sold in the UK a flexible chopping mat (RosMat) which is referred to in the printed brochures and advertising materials attached to this Declaration. The subject matter disclosed in the UK Patent GB2 248 177 relates to RosMat.
4. On August 8 1997 I signed a declaration which I understand was to be submitted on behalf of Progressive Intl Corp, in a patent infringement action filed by New Age Products Inc against Progressive Intl Corp. I understand that this action relates to a United States Patent 5,472,790 for a chopping mat type product ("New Age Patent").
5. I have read the New Age Patent and understand the invention it describes and claims. I am experienced in the field of plastics and understand the technical terminology used in that patent, including flexural modulus and Rockwell hardness. As a result of my experience I believe I can at least roughly estimate the range of flexural modulus and Rockwell hardness in which a particular cutting mat product falls by the feel of the product and the ease or difficulty with which it can be penetrated by a knife.

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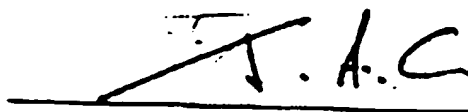
6. The declaration that I signed on August 8 1997 is accurate, however when I gave that declaration I was not asked to describe the RosMat. In particular I was not asked anything about its hardness or flexibility or other properties.
7. The Rockwell hardness and flexural modulus of the ROSmat has never been formally tested. Nevertheless I have some appreciation of its properties of hardness and flexibility. In this regard the RosMat was far thicker than that described or claimed in the New Age patent.
8. -- I have examined a cutting mat produced by New Age that I have been informed is within the scope of the claims of the New Age Patent ("New Age Mat"). Although I did not conduct any tests other than visually inspecting it, flexing it in my hands and attempting to cut it with a knife, I gained an appreciation of its thickness, flexibility and hardness from this examination.
9. I have compared the RosMat to the New Age mat. Despite the fact that RosMat is softer, because of its thickness, it cannot be used to form a complete funnel for food pieces. The RosMat was not intended for this use and could not have been sold to customers for this purpose. At best it can be

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flexed as shown in the UK Patent and our literature.

10. Based on my comparison I believe the flexural modulus and Rockwell hardness of the RosMat are not within the ranges described in the New Age patent.
11. Furthermore, based on my understanding of the properties of flexural modulus and Rockwell hardness I believe that the flexural modulus and Rockwell hardness of the RosMat were not within the ranges described in the New Age patent. Despite the apparent similarities, the mat shown and described in the New Age patent is functionally (in the sense that the RosMat cannot be rolled up like the New Age mat), and structurally different from the RosMat, in that the maximum gauge of the New Age mat is less than the minimum gauge of the RosMat. See Patent application no. GB2-248 177

I declare under penalty of perjury, under the laws of the United States of America, that the foregoing is true and correct. Executed this 22 day of August 1997 at ASHBURTON England.


JOHN COX

09044518-012308

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Reissue Application of)	FOR: PREPARATION AND
)	TRANSFER SHEET
Patentee: RODERICK THOMPSON)	
)	
Patent No.: 5,472,790)	Reissue filed: herewith
)	
Issue Date: December 5, 1995)	Art Unit: unknown
)	

SUPPLEMENTAL REISSUE DECLARATION BY INVENTOR

Assistant Commissioner of Patents
Washington, D.C. 20231

Dear Sir:

This declaration supplements the Reissue Application Declaration by the Inventor under 37 C.F.R. § 1.175 filed concurrently herewith.

**STATEMENT OF INOPERATIVENESS OF ORIGINAL PATENT
UNDER 37 CFR 1.175(a)**

I, Roderick Thompson, the named inventor in the above-referenced patent, declare and say as follows:

The original patent is partly or wholly inoperative. Indeed, I have been informed that a request for reexamination was recently granted by the PTO. The inoperativeness results from the claims being directed to a plastic sheet having certain structural and material properties, such that the claims could be read on any sheet of plastic having such properties, regardless of whether that sheet is a flexible cutting sheet for food preparation. The claims include an error in their characterization of my invention solely

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as an article of manufacture that is intended to be used for food preparation, rather than as, for example, a method for using that flexible plastic sheet for cutting and handling food or as an article of manufacture comprising means for performing its functions. Certain claims also include an error in their overly broad recitation of the thickness of the plastic sheet. These errors arose without any deceptive intention, resulting in claiming more than the patentee had a right to claim.

1. The Invention is Not so Broad as to be Merely a Sheet of Plastic

I have always regarded my invention as a flexible plastic cutting mat made from a plastic sheet material having properties that give my invention an advantageous combination of flexibility, strength, durability and other qualities lacking in prior flexible cutting mats. The claims of the patent define a group or class of suitable plastic sheet materials by reciting specific combinations of thickness, Rockwell hardness, flexural modulus, cantilever beam strength and lay-flat properties. Yet, I did not invent the plastic sheet material itself. I am neither the first person to have conceived of using a flexible plastic sheet of some type for food preparation, nor am I the first person to have conceived of the class of plastic sheet materials recited in the claims; I am not a polymer chemist or plastics expert. Rather, my invention as I regard it and have always regarded it lies in the *combination* of the plastic sheet material and its use as a flexible cutting mat.

I now believe that the claims should have been drafted more narrowly, in the form of method-of-use claims having limitations upon the properties of the plastic sheet material or in the form of article-of-manufacture claims having means-plus-function limitations. Instead, they were drafted too broadly, in the form of article-of-manufacture claims limited only by the recitation of an intended method of use of the article. The error was first discovered some time after the patent owner asserted the patent in litigation against an infringer early in 1997. It became increasingly clear as a result of

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prior art information that came to light during the litigation discovery process that the patentee was not entitled to claim the plastic sheet material *per se*. It became increasingly clear that the plastic sheet material itself was not patentable in and of itself because the same or very similar material was known in the prior art, and that the claims should have been drafted more narrowly. Furthermore, the newly discovered prior art information includes information regarding the Counter Maid product, which was cited in the patent, indicating that the thickness I had estimated for the Counter Maid was incorrect. The information regarding the Counter Maid product was brought to the patent owner's attention in late October of 1997 and, to the best of my knowledge and belief, this reissue application was begun without delay after careful consideration of all of the prior art information that had come to light.

The patent application as originally filed included claims directed to the method of making the cutting mat by extrusion, but it did not include any claims directed to the method of using the cutting mat. The omission of such claims was unintentional, and I consider and have always considered my invention to include the method of using the mat.

That my invention includes the method of using the mat is supported by the patent specification, which in col. 4, lines 15-44 describes in some detail a method that includes the steps of slicing a food article upon the mat and then flexing the mat into an arcuate trough or funnel shape and raising one end to cause the cut pieces of food to slide through the trough into a bowl. This method of use is also described in col. 2, lines 1-21.

To correct the above-described error in this reissue application, an amendment of the claims is proposed in which the preambles of claims 1-9 are revised to reflect the method-of-use format rather than the article-of-manufacture format, and the bodies of the claims are revised to characterize the mat via a step of "providing" a sheet having

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the requisite properties. Steps have also been added to independent claims 1 and 6 to recite that the mat is placed on a flat surface, a food article is placed on the mat, the food article is cut with a knife, the mat is flexed into an arcuate trough shape, and the cut food pieces are funneled through the trough. Support for these steps is found in the specification in column 4, lines 15-44. A new independent claim, claim 10, is also proposed. Claim 10 includes limitations similar to claims 1 and 6, but recites the properties of the plastic sheet in means-plus-function format. A new article-of-manufacture claim, claim 11, is also proposed. It recites the sheet partly in terms of a combination of means for performing the functions of resisting curling, inhibiting perforation by a knife when food articles are cut upon it; and accommodating flexure into an arcuate trough shape having a certain cantilever beam strength. The limitations recited in the newly proposed claims are essentially the same as those recited in the other claims and thus are fully supported by the specification.

The error arose without any deceptive intent. I have been informed that in the pending litigation relating to the patent, the defendant has argued that whether the sheet material was known in the prior art was knowingly omitted or misrepresented to the Patent and Trademark Office (PTO), in violation of the duty of candor. I take offense at that allegation, which impugns the honesty of me and the patent attorneys who represented me. The defendant makes too much of statements made in the prosecution of the original application relating how I came to make the invention. The following more detailed explanation should make clear that I had no intent to deceive the PTO and that I had no intent to withhold or misrepresent any information material to patentability that there was a duty to disclose.

A flexible cutting mat that apparently was known by the name "Counter Maid" was what spurred me to make the invention. To the best of my knowledge and belief, the existence of this mat and all I knew about it, including a printed advertisement

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relating to it (the "Counter Maid Product Brochure" cited in the patent), was fully disclosed to the PTO. Some time in the mid-1980s, I obtained a sheet of plastic that a family friend, Marian Gillett, had been attempting to market as a flexible cutting mat on which one could cut food and then flex the mat to funnel the cut food into a bowl. I also obtained a copy of a Counter Maid Product Brochure that Ms. Gillett had. I did not know whether she had actually sold any mats. I did not conduct any tests on it, but I recall that at the time it appeared to me to be quite thin and flimsy, almost like waxed paper.

Also, I inferred at the time that Ms. Gillett was the publisher of the Counter Maid Product Brochure and that it was published in or about 1983. I have been informed that information has recently come to light in the above-mentioned litigation that suggests Ms. Gillett had worked with another person, a Mr. William Fishman, on the Counter Maid product. I did not at any time during the pendency of the original patent application know anything about Mr. Fishman's involvement with the Counter Maid or any other prior cutting mat. Furthermore, in view of Mr. Fishman's involvement, it is not inconceivable that what I attributed to Ms. Gillett could have been the work of Mr. Fishman or both of them, including the marketing of the Counter Maid product and the publishing of the brochure. I do not know whether this information is relevant to the reissue application, but it seems important to clarify my knowledge of the Counter Maid Product Brochure and how I came to make the invention.

The defendant suggested in the litigation that I knew more than I disclosed to the PTO about the Counter Maid, but this is untrue. At the time the patent application was being prosecuted in the PTO, I was unable to locate Ms. Gillett's mat, though I recall having shown it to my patent attorneys when we first discussed preparing a patent application. I had on occasion cut pieces off it to show to various plastics companies to explain the problems with it I was attempting to overcome, and I suppose I may have

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lost it a piece at a time. In any event, if any scraps of it remained in my possession, I could not have identified them as having been from Ms. Gillett's mat, since I had various pieces of plastic in my possession from time to time while I was working on the invention. What was represented to the PTO regarding the Counter Maid product was based on my recollection and that of my patent attorneys at the time the statements were made. It is my understanding that it was represented to the PTO that the Counter Maid was "an unknown plastic material with a low flexural modulus, hardness and thickness (approximately 0.005")." I can confirm that that statement accurately represents my recollection of the Counter Maid at the time the statement was made. I have now been informed that additional samples of what is presumably the Counter Maid mat were recently discovered in Mr. Fishman's possession in the course of the above-mentioned litigation. (See Declaration of Marvin Mick, submitted herewith.) Although I have not seen one of Mr. Fishman's mats, I have been informed that the thickness may be somewhat greater than the estimated 0.005 inches. Thus, the estimate may have been incorrect, but it was clearly not made with any deceptive intent, since it comports with my recollection of the approximate thinness of the mat Ms. Gillett gave me. The incorrect estimate was most likely due to the impression of flimsiness that the mat conveyed, which one would surmise must have been caused by it being made of a different material from that specified in the patent claims. The estimate may even have been correct, since I cannot determine with certainty whether the mat I received from Ms. Gillett was the same as the mats recently discovered in Mr. Fishman's possession. Nevertheless, since I know of no evidence to the contrary, for purposes of this reissue I will continue to assume that what I had in my possession was the Counter Maid product depicted in the circa 1983 Counter Maid Product Brochure, and which was at least offered for sale, if not sold or given away, to an extent sufficient to qualify it as prior art.

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In any event, I recognized problems in the Counter Maid that could be overcome by using a different plastic. While I am not an expert in plastics, I have had some experience with manufacturing and marketing novel plastic products, and I recognized that the solution to the problems lay in the plastic. The problems as I perceived them included that the Counter Maid was too flimsy; it could not support—to paraphrase the patent claims—a weight of at least five ounces when placed ten inches from the end at which the mat is held when the mat is flexed and held in the trough shape illustrated in the patent. The problems also included that the mat was too easily penetrated by a knife. It occurred to me that a thicker and/or harder material was needed, though it could not be so hard that it would dull a knife in ordinary use. An important consideration was that the thickness, hardness and flexibility needed to be carefully balanced, since the mat needed to be flexible into the trough shape and function as a funnel, as described in the patent. Also, the Counter Maid's problems included a bias toward a curvature that I believed was due to the Counter Maid having been cut from plastic that had been wound on a roll by the manufacturer following extrusion. Plastic that was never wound on a roll by the extruder or that otherwise had lay-flat characteristics was needed. With these requirements in mind, I scoured the country for a company that could provide a plastic sheet material that met them. I spoke with numerous plastics suppliers on the telephone before one of them, Witt Plastics, indicated that they could meet my requirements. Witt Plastics was a custom extruder, and to the best of my knowledge and belief they extruded the plastic sheet material I ordered specifically for me. To the best of my knowledge and belief, the resin that they extruded into the sheets was that which is identified in the patent, manufactured by Rexene Resins. To the best of my knowledge and belief, I did not inquire and do not know whether Witt Plastics had ever made sheets from that particular resin or an equivalent resin. I did no research on the prior art in that regard. I do know that plastic

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sheet material in the thickness range in which I was interested was difficult to find in flat sheets, i.e., not having been wound on a roll by the extruder. There may very well have been suppliers other than Witt Plastics who could provide it, but none of them that I spoke with could do so. I am not an expert in the patent law, but I felt that, while the plastic sheet material was not unknown, the fact that it was relatively scarce or uncommon should carry some weight in considering whether it would have been obvious to make a flexible cutting mat from such material. I obtained some samples from Witt Plastics that were about 10 or 15 mils in thickness and conducted tests on them by using them for their intended purpose as described in the patent.

In view of the above, it should be clear that there was no violation of the duty of candor owed the PTO in connection with the original patent application. There was absolutely no intent to withhold or misrepresent any information that would have been material to patentability. Furthermore, by means of the Declaration of Marvin Mick, I am disclosing the above-described newly discovered information regarding the Counter Maid product, which there may be a duty to disclose in this reissue application.

I have also been informed that the defendant in the litigation has attempted to make an issue out of the fact that I am not an expert in plastics and am not very familiar with the parameters of Rockwell hardness and flexural modulus. I do not see how this is relevant. I worked with my patent attorneys to determine how best to draft the claims, and we decided that Rockwell hardness and flexural modulus were two important parameters that at least partly characterized the type of plastic I selected. As I discussed above, the plastic is not in itself my invention, but I needed to find the best way to describe its relevant properties. It is my understanding that writing a patent application, including choosing the most appropriate and technically proper language to articulate an invention, is typically the job of the patent attorney and not necessarily something the inventor must do. As the defendant would have it, I should somehow be

penalized because the patent attorneys were able to help me articulate my invention with the technical and legal precision that the law requires. Working together, my patent attorneys and I arrived at what we thought was the best way to articulate the invention, and at the time I signed the patent application declaration attesting to my inventorship, I understood the claims and believed that they set forth what I regarded as my invention.

2. Original Claims 1, 2, 4 and 5 Recited Too Broad a Thickness Range

In the Continuation-in-Part (CIP) patent application from which the patent issued, the thickness range of the plastic material was broadened from that disclosed in the parent application, but sales of a product within the scope of the broadened claims were inadvertently not disclosed to the PTO. Specifically, more than one year before the CIP was filed on June 13, 1994, the patent owner and/or its licensee sold a flexible cutting mat having a thickness in the range of 0.008-0.030 inches and that was otherwise believed to be within the scope of the CIP claims. I have been informed that such sales may constitute a bar to patentability of the claims that recited the broadened range, claims 1, 2, 4 and 5. Therefore, the claims in the reissue application have been narrowed to limit them to the thickness ranges disclosed in the parent application. The error was discovered during the course of the litigation when the defendant raised the issue.

This error arose without any deceptive intent. It was reasonable to believe that the information regarding the product sales in the intervening period between the filing of the parent application and the filing of the CIP application did not need to be disclosed to the PTO because the information related to a product covered by claims entitled to the protection of the early filing date of the parent application. Intuitively, one would believe that sales of product of a type covered by the claims of the parent application that occurred *after* the filing of the parent application could not affect the

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patentability of any claims, because the early filing date of the parent claims would shield the relevant subject matter recited in them. Nevertheless, I have been informed that the case law has held that it is not the subject matter recited in a claim that is entitled to the shielding effect but rather only each claim as a whole. Although I understood my duty to disclose to the PTO information that would be relevant to patentability, I did not appreciate that such sales were relevant. The issue, as I presently understand it, appears to revolve around quite a technical point of patent law. Not only did I not intend to deceive the PTO, but lacking an understanding of this point of law, it would be unreasonable for anyone to now believe I could possibly have intended to deceive the PTO. While a mistake of law may or may not in itself be grounds for reissue, the filing of the reissue application provides an opportunity to correct this error by narrowing the overly broad thickness range recited in claims 1, 2, 4 and 5.

CONCLUSION

Since the invention claimed in amended claims 1-9 and new claims 10 and 11 is unchanged from that described in the specification, no new figures are required. The features of the claimed invention are fully disclosed and illustrated in the original disclosure as filed.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements and the like so made are punishable by fine or

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imprisonment, or both, under § 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Dated: 1-23-98


RODERICK THOMPSON
Inventor

New Age Products, Inc., the assignee of record in the patent, hereby assents to the reissue application as set forth above.

Dated: 1-26-98


MARVIN MICK
President
New Age Products, Inc.